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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,415	10/20/2000	Kia Silverbrook	NPA011US	1266
24011	7590	03/18/2005	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			PHAM, THIERRY L	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/693,415

Applicant(s)

SILVERBROOK ET AL.

Examiner

Thierry L Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-11,14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-11,14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This action is responsive to the following communication: RCE filed on 1/14/05.
- Claims 4-5, 12-13 have been canceled; Claims 1-3, 6-11, 14-15 are pending in application.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. Please note: An acknowledgement of foreign priority (PQ3632, filed on October 25, 1999) was sent along with Non-Final office action on 6/15/04.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 6, 8-9, 11, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman et al (U.S. 6330976), Ur (U.S. 6072871), and further in view of Markowitz (U.S. 5513254).

Regarding claim 1, Dymetman discloses a method of producing a document by formatting user requested information in the document (marking medium contains both coded data and human readable information, col. 7, lines 42-58 and col. 17, lines 35-40) so as to include one user interactive element (i.e. marking medium contains coded data which allows users to retrieve digital copy from remote system via using optical pointer 502, fig. 2), to allow the user to effect a response to the information, using a sensing device (optical pointer 502, fig. 2) for transmitting response back to a computer system (computer system, figs. 1-2), including:

- printing (col. 11, lines 55-60) the document, having advertising material in the advertising space (i.e. sales catalogue contains coded data which allows users to place an order by clicking on an item via using a pointer 502, col. 19, lines 33-42), together with coded data, said coded

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data being indicative of an identity of the document (identity of the document and zones within the coded marking medium, col. 3, lines 60-67 to col. 4, lines 1-23) and of the at least one interactive element.

Dymetman discloses a marking medium contains both coded data and human readable information (col. 14, lines 39-45, col. 35-39, and col. 19, lines 33-42) but fails to teach and/or suggest an inkjet printer prints the coded data at the same time as printing the document on the surface defining structure.

Ur, in the same field of endeavor for printing, teaches an ink jet printer (printer 17, fig. 1) prints the coded data at the same time as printing the document on the surface defining structure (prints coded data 27 and document texts as shown in fig. 2 at the same time, col. 4, lines 41-47).

However, the combinations Dymetman and Ur do not teach and/or suggest a method for identifying an advertising space outside an area of the document to be occupied by the information.

Markowitz, in the same field of endeavor for printing, teaches a method for identifying an advertising space outside (identifying an available white space within the document, fig. 4, abstract, col. 4, lines 45-57) an area of the document (i.e. below the text/graphic area, fig. 4c) to be occupied by the information.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Ur and Dymetman as per teaching of Markowitz because of a following reason: (1) a sensing device for sensing invisible coded data incorporated within the document (Dymetman, col. 12, lines 65-67); (2) printing an advertisement on an available white space of the document preventing an overlap between an advertisement and the document (3) reduce hardware costs and time by printing both coded data and document data simultaneously.

Therefore, it would have been obvious to combine Markowitz, Dymetman, and Ur to obtain the invention as specified in claims 1 & 9.

Regarding claims 3 & 11, Markowitz further discloses a method as claimed in claim 1 wherein the information is formatted at a publication server (fax server, fig. 3, col. 6, lines 1-54) of the computer system and the method includes the publication server monitoring the said area

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and, once the space is identified, receiving the advertising material from an advertising server (selecting advertisement from database, fig. 2, col. 6, lines 54), for including in the document.

Regarding claims 6 & 14, Dymetman further teaches a method as claimed in claim 5, which includes printing the coded data to be substantially invisible (col. 11, lines 45-50 and col. 12, lines 60-67) in the visible spectrum.

Regarding claim 8, Dymetman further teaches a method as claimed in claim 1, wherein the sensing device (reference 502, fig. 1-2, fig. 8) includes an identification code (network address, fig. 8, col. 9, lines 24-45) specific to a particular user and the method includes monitoring (server, col. 5, lines 10-36) of the sensing device in the computer system.

Claims 2, 7, 10, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz, Dymetman, and Ur as applied to claims 1 and/or 9 above, and further in view of Reiter (U.S. 6178411).

Regarding claims 2 & 10, the combinations of Markowitz, Dymetman, and Ur do not explicitly teach a method wherein the advertising space is determined to be on a reverse side of the document relative to the user requested information.

Reiter, in the same field of endeavor for advertising distribution, teaches a method wherein the advertising space is determined to be on a reverse side of the document relative to the user requested information (col. 2, lines 42-57 and col. 11, lines 1-4).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Markowitz, Dymetman, Ur as per teachings of Reiter because of a following reason: (1) printing advertisements/coupons on the back/reverse side of the document provides another option/way of distributing ads; therefore, increasing ads distribution flexibilities.

Therefore, it would have been obvious to combine Markowitz, Dymetman, Ur with Reiter to obtain the invention as specified in claims 2 & 10.

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Regarding claims 7 & 15, Reiter further teaches retaining a retrievable record of the printed document (print report, col. 5, lines 50-67).

Response to Arguments

Applicant's arguments, see page 4, filed on 1/14/05, with respect to the rejection(s) of claim(s) 1 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art reference (US 6072871).

Applicant's arguments, see page 4, filed 1/14/05, with respect to *112, first paragraph* rejection have been fully considered and are persuasive. The *112, first paragraph* rejection of claims 1 and 9 has been withdrawn.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

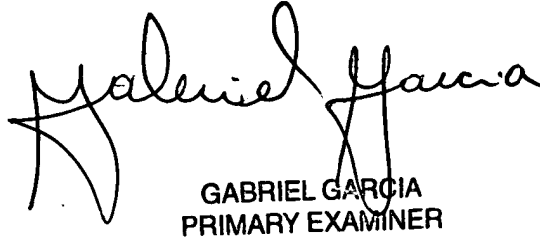
Thierry L. Pham



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GABRIEL GARCIA
PRIMARY EXAMINER